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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,158	02/27/2004	Grant Hay	040849-0256	4601
22428 7590 03/13/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER TON, ANABEL	
			ART UNIT	PAPER NUMBER
			2875	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/787,158	HAY ET AL.	
	Examiner	Art Unit	
	Anabel M. Ton	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 36-45 and 77-91 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-60, 68-72 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 35, 46-52, 61, 64-67 and 73-76 is/are rejected.
- 7) ☒ Claim(s) 4-6, 10-34, 62 and 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/09/12/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-35, 46-76, without traverse, has been acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3,7-9,35,46-52,73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willems et al (6,194,497).
4. The recitation "a light diffusing film for a backlight display" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
5. Willems discloses a material consisting essentially of a polycarbonate and a uniformly dispersed anti-static material in an amount sufficient to impart anti-static properties. Willems does not specifically disclose the material being a unitary film. It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Willems as a unitary film, since Willems states that the final product is a molded article made of a polymer (col. 2 lines 44-53), thus making this molded article into a unitary film is well within ordinary skill.

- With regards to the recitation of the surface resistivity of the film is below about 10^{15} ohm/square, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the film of Willems with a resistivity of 10^{15} ohm/square since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to the recitation of the film having a thickness of about 0.025 mm to about 0.5 mm, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the film of Willems about .025mm to .5mm since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to the recitation of the film has a gloss value according to ASTM standard D523 of less than about 50; the film has a gloss value according to ASTM standard D523 of greater than about 90; It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to satisfy the requirements of the ASTM Standards with the device of Willems (as

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recited in 8 and 9), since satisfying the operational and/or regulatory requirements of a particular application would have flown naturally to one of ordinary skill in the art.

- With regards to the film having a retardation value of less than about 100 nm, less than about 50 nm, less than about 21 nm, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the material of Willems to have the aforementioned values, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to the film having a weight loss of 0.0020gms or less in 100 rounds of Taber testing, It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to satisfy the requirements of the Taber testing Standards with the device of Willems (as recited in claim 35), since satisfying the operational and/or regulatory requirements of a particular application would have flown naturally to one of ordinary skill in the art.
- With regards to the film flatness being less than 0.1 inches, less than 0.01 inches, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form that material of Willems to the aforementioned flatness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.

- With regards to the edge curl of the film is less than 0.08 inches, less than 0.06 inches, It would have been obvious to one of ordinary skill in the art at the time the invention was made to form an edge curl of the material of Willems in the aforementioned measurements, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to the film bagginess being less than 0.05 inches, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a film bagginess of the material of Willems to .05 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to the film having a surface with a surface Ra greater than 0.6 microns, greater than 0.7 microns, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the surface of the material of Willems with a surface Ra to the abovementioned specifics, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.
- With regards to claim 73, Willems discloses a material consisting essentially of polycarbonate and a uniformly dispersed anti-static material comprising a

fluorinated phosphonium sulfonate in an amount sufficient to impart anti-static properties to the material the surface resistivity of the film being below about 10^{15} ohm/square (10^{13} - 10^{14} Ohm). Willems does not disclose the material specifically being a unitary film. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Willems as a unitary film, since Willems states that the final product is a molded article made of a polymer (col. 2 lines 44-53), thus making this molded article into a unitary film would have been well within ordinary skill.

- With regards to claim 74, Willems discloses the claimed invention including the unitary film being substantially transparent. Willems does not disclose the material being a unitary film. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Willems as a unitary film, since Willems states that the final product is a molded article made of a polymer (col. 2 lines 44-53), thus making this molded article into a unitary film would have been well within ordinary skill.
- With regards to the unitary film having a transmission of greater than about 80%, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the material of Willems with a transmission of greater than 80%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.

6. Claims 61,64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graf et al (6,908,202) and further in view of Willems.

Graf discloses a backlight display with an optical source for generating light, a light guide for guiding the light there along and a unitary diffusive film made of a polycarbonate. Graf does not disclose the film consisting essentially of polycarbonate and a uniformly dispersed anti-static material in an amount sufficient to impart anti-static properties to the film. Willems discloses a material consisting essentially of polycarbonate and a uniformly dispersed anti-static material in an amount sufficient to impart anti-static properties to the material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the diffusive film of Graf to include the aforementioned anti static properties of Willems, since Willems teaches the material to have optical properties, and the anti static properties of the material of Williams are old and well known in the art to prevent dust or foreign matter accumulation to the material to prevent a decrease in efficiency of the material when placed in a desired application. In the case of Graf, one would have been motivated to implement the antistatic optical material of Willems in Graf since it would prevent foreign matter accumulation on the diffusive film of Graf as opposed to a diffuser without antistatic properties to increase the efficiency of the diffuser of Graf.

- With regards to the film having a thickness of about 0.025 mm to about 0.5 mm, it would have been obvious to one of ordinary skill in the art at the time the

intention was made to make the film of Graf in further view of Willems the abovementioned measurements, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233.

- With regards to the particles have a gloss value according to ASTM standard D523 of less than about 50 and less than about 90, It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to satisfy the requirements of the ASTM D523 Standards with the device of Graf in further view of Willems (as recited in claims 65 and 66), since satisfying the operational and/or regulatory requirements of a particular application would have flown naturally to one of ordinary skill in the art.
- With regards to said unitary film additionally comprising at least one textured surface for the low scattering of light, Graf discloses at least one textured surface.

Allowable Subject Matter

7. Claims 53-60,68-72 are allowed.
8. Claims 4-6,10-34,62,63 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M. Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AMT

Anabel M Ton
Examiner
Art Unit 2875